

REMARKS

Claims 24-46 presently appear in this case. No claims have yet been examined on the merits. All the claims have been subjected to a Restriction Requirement and an Election of Species Requirement. Reconsideration and withdrawal of the requirements are respectfully requested.

On page 2, the Examiner argues that claims 24-46 are generic to the following patentably distinct inventions of unrelated chemical structure and function, which share no special technical features:

- a) baculovirus p35 gene,
- b) a cowpoxvirus crmA gene,
- c) herpesvirus-derived v-FLIP gene,
- d) a baculorius v-IAP gene, and
- e) an adehnovirus AdI4.7 gene.

The Examiner states that applicants are required under 35 U.S.C. §121 to elect a single disclosed invention from Groups (a)-(e).

In addition, the Examiner states that each group above is directed to the following distinct species of unrelated structure:

- 1) Chinese hamster ovary cells (CHO cells); a mouse myeloma cell; a BHK cell; a 293 cell; and a COS cell (see claim 30); and

2) any of the promoters recited in claims 32-33.

The Examiner contends that Applicants must elect one invention from Groups a-e above and a single species from each of Groups 1-2 above. The Examine argues that it would require an undue burden to search and examine these patentably distinct inventions (as well as species) due to their structural and functional characteristics.

In reply to the Restriction Requirement, Applicants hereby provisionally elect, with traverse, Group (a) baculovirus p35 gene, for examination on the merits. As to the Election of Species Requirement, Applicants hereby provisionally elect, with traverse, Chinese hamster ovary cells from Group 1 and the species of chicken  $\beta$ -actin promoter of Group 2 as the species for examination on the merits. It is respectfully submitted that at least claims 24-46 are readable thereon.

The reasons for traverse are as follows.

To start, the requirement is improper as a matter of law. This application is a 371 national stage application of international application PCT/JP04/15594. As such, the Office is required to following the rules regarding unity of invention and PCT Rules 13.1 and 13.2. However, the Office has not done so. Indeed, the Examiner has given no proper reason why there is a lack of unity of invention under the applicable PCT Rules 13.1 and 13.2. It also appears that the Examiner attempts to

improperly apply U.S. restriction practice for this application and not the PCT Rules for unity of invention. See, Caterpillar Tractor v. Commissioner of Patents and Trademarks, 650 F. Supp. 218 (E.D. Va. 1986); and also MPEP §1850.

Further, it should be noted that a determination of lack of unity is possible only when the claims of different groups lack a "special technical feature" relative to one another. This is not the case here. The Examiner's attention is directed to the fact that unity of invention with respect to national stage applications is discussed in MPEP §1893.03(b). It is explained that the Office should refer to MPEP §1850 for a detailed discussion of unity of invention. In this regard, MPEP §1850 II states that unity of invention has to be considered in the first place only in relation to independent claims, and not the dependent claims. If the independent claim is directed to a single invention, it does not matter that the dependent claims may encompass a multitude of inventions.

In the instant case, claims 1 and 2 are true generic claims. They relate to a single special technical feature which defines over the prior art, i.e., the presence of recombinant production amount potentiating factor. It is totally improper to base a unity of invention requirement on dependent claims. For this reason, reconsideration and withdrawal of the requirements is requested.

In addition, the Examiner's attention is directed to PCT Rule 13.2 and part 1b of the Annex B of the administrative instructions under the PCT, which specifies that "special technical feature" is defined as meaning a feature that defines the contribution which each of the inventions, considered as a whole, makes over the prior art.

In other words, PCT Rule 13.2 is art-based and requires the citation of a publication showing the "special technical features". Therefore, absent any showing that the "special technical feature" shared by all the claims is present in a prior art reference, no determination of lacking of unity can be properly made. In the instant case, the Office has failed to provide such a citation. Thus, Applicants believe that the unity of invention requirement should not be applicable here.

For these reasons, the Examiner has failed to satisfy its burden in showing that claims lack unity of invention under the requirements of PCT Rule 13.1 and 13.2.

Further, Applicants respectfully submit that all claims are directed to a single general inventive concept sharing the same or corresponding "technical feature".

Thus, it is believed that Applicants are entitled to action on the merits of all pending claims, in their full scope, in the present application. Reconsideration and withdrawal of the requirements is therefore earnestly solicited.

In addition, even if U.S. restriction practice were to apply (which it does not), it is believed that restriction in this case would have been improper. It is well established that there are two criteria for a proper requirement for restriction: 1) the inventions must be independent (see MPEP §802.01, 806.06, and 808.01) or distinct as claimed (see MPEP §§806.05-806.05(j)); and 2) it would present a serious burden on the Examiner if restriction is not required (see MPEP §§803.02, 808 and 808.02). Applicants respectfully submit that the claims do not meet these criteria, because the claims of the different groups contain overlapping and related subject matter that is generic to all of the claims, as discussed above. Consequently, a search of the invention of one group would necessarily overlap that of the other group. Thus, it is believed that a search of all the claims in their entire scope would not constitute a serious burden on the Office given their related and overlapping subject matter.

Thus, Applicants submit that the Office's request for restriction is improper. Kindly, search and examine all of the claims in their full scope together in this application as the inventions of the different groups have unity of invention.

In the event that the Office disagrees with the traversal and maintains the Restriction Requirement, then kindly consider the possibility of rejoinder of the non-elected subject

Response dated August 17, 2009

Reply to Office action of April 17, 2009

matter, upon determination and allowance of the elected invention, per U.S. rejoinder practice (see MPEP §821.04).

As to the election of species requirement, in the event that the Office disagrees with the traversal and maintains the requirement, then kindly consider and examine additional species, upon determination and allowance of the generic claims, in accordance with U.S. election of species practice.

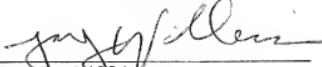
Favorable action on the merits is respectfully requested.

If the Examiner has any proposal for expediting prosecution, please contact the undersigned attorney at the telephone number below.

Respectfully submitted,

BROWDY AND NEIMARK, P.L.L.C.  
Attorneys for Applicant(s)

By

  
Jay D. Williams  
Registration No. 48,036

JFW:pp

Telephone No.: (202) 628-5197

Facsimile No.: (202) 737-3528

G:\BRI\JW\CH1\Maleynnn2\Pt01\2009-08-17\ResponseToOfficeAction.doc